

REMARKS

The Applicants would like to thank the Examiner for the quick and courteous Office Action. The Examiner helpfully allowed claims 40-42 over the art of record for which the Applicants are particularly appreciative.

The claims remaining in the application are 20-29, 31-38 and 40-43. Claims 1-19 and 39 were previously withdrawn, and are now cancelled herein without prejudice to Applicants' right to present such claims at a later date in a continuing application. Claim 30 is cancelled herein. Independent claims 20, 24, and 27 are amended herein.

Restriction Requirement under 35 U.S.C. §121

The Examiner acknowledged Applicants' election with traverse of the Group II claims in the reply filed on 10/7/05. The Examiner contends that the requirement is still deemed proper and made it final.

The Applicants hereby respectfully direct the Examiner's attention to the fact that non-elected, withdrawn claims 1-19 and 39 have been cancelled herein without prejudice to Applicants' right to present such claims at a later date in a continuing application. Applicants thus respectfully submit that the instant restriction requirement is overcome and rendered moot. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §102(b) over Ricci, et al.

The Examiner rejected claims 20-24, 26-28, 30, 33, 35, and 37 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pat. No. 5,164,433 to Ricci, et al. The Examiner finds that Ricci, et al. teaches a thickener composition which may be used in oil well drilling, which comprises latex, a surfactant, aluminum silicate (precipitating agent) and a salt, such as calcium carbonate. The latexes would have particle sizes within the scope of claim 37. Such would inherently inhibit borehole wall invasion.

The Applicants would respectfully traverse. A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir.), cert. denied, 116 S.Ct. 516 (1995).

The Examiner's attention is respectfully directed to the amendments to independent claims 20, 24 and 27 herein where the polymer latex is further specified as "selected from the group consisting of polyethylene, carboxylated styrene/butadiene copolymer, sulfonated styrene/butadiene copolymer, polyvinyl acetate/vinyl chloride/ethylene copolymer, polyvinyl acetate/ethylene copolymer, polydimethylsiloxane, and mixtures thereof". Support for these amendments is found in dependent claim 30 and 39-42 as originally filed, and elsewhere, and thus they do not constitute improper insertions of new matter. The Examiner's attention is further respectfully directed to the fact that the following latexes are not included in this Markush group: polymethyl methacrylate, polyvinylacetate copolymer, natural latex, and polyisoprene.

Ricci, et al. involves a rheological agent and thickener composition for aqueous systems, comprising a mixture of clay, such as hectorite, a synthetic polymer and a starch-type material. The mixture provides efficient thickening, sag resistance, spatter resistance and stability in water-based systems, particularly in latex-based coatings. (Abstract therein.) The only latexes disclosed or mentioned in Ricci, et al. are at column 5, lines 43-47 ("the polymerization product of ethylenically unsaturated carboxylic acid monomer, modified ethylenically unsaturated carboxylic acid monomer and/or vinyl or modified vinyl monomer such as vinyl acetate"). It is respectfully submitted that the single prior art reference does not disclose each and every limitation of the claims, as amended herein. That is, the amended list of latexes in independent claims 20, 24 and 27 does not overlap those taught in Ricci, et al. It is thus respectfully submitted that the claims as amended herein are not anticipated by the single Ricci, et al. reference. The 35 U.S.C. §102(b) rejection is thus overcome. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §102(b) over GB 2351986

The Examiner rejected claims 20-31 and 33-37 under 35 U.S.C. §102(b) as allegedly being anticipated by GB 2351986. The Examiner finds that GB 2351986 teaches a method of drilling using a drilling fluid comprising a latex, water, a surfactant, salts, and a silicate or alumino-silicate (clays), which are allegedly the same as the precipitating agent of the present invention. The Examiner asserts that the latexes would have particle sizes within the scope of claim 37. Such would inherently inhibit borehole wall invasion.

The Applicants would again respectfully traverse. A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, *id.*

GB 2351986 relates to compositions for forming a filter cake on the wall of a borehole comprising a latex compound which is insoluble and non-swellable in water (Abstract therein). The Applicants respectfully note that upon review of GB 2351986 they were unable to locate any teachings therein concerning clays or alumino-silicates, although silicates were mentioned. The polymer latexes taught by GB 2351986 are styrene-butadiene latex, styrene-acrylate-methacrylate terpolymer latex, polymers of vinyl acetate, polymers of isoprene and polymers of esters of acrylic and methacrylic acid (Abstract and page 4, lines 11-26 therein). Again, however, it is respectfully submitted that these latexes are not those recited in independent claims 20, 24 and 27 as amended herein. (These amendments do not constitute improper insertions of new matter; please see the discussion of the amendments to the claims in the immediate previous section with respect to Ricci, et al.) It is thus respectfully submitted that the single GB 2351986 prior art reference does not disclose each and every limitation of the claims, as amended herein. The 35 U.S.C. §102(b) rejection is thus overcome. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §102(b) over GB 2131067

The Examiner rejected claims 20-24, 26-31, 33, 36, and 37 under 35 U.S.C. §102(b) as allegedly being anticipated by GB 2131067. The Examiner

finds that GB 2131067 teaches method of drilling using a drilling fluid comprising a latex, water, surfactant, and bentonite which is an alumino-silicate, allegedly the same as the precipitating agent of the present invention. The Examiner asserts that the latexes would have particle sizes within the scope of claim 37. Such would inherently inhibit borehole wall invasion.

Once more the Applicants would respectfully traverse. A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, *id.*

GB 2131067 involves the addition of minor proportions of a polymer, which is insoluble in water, to oil-based or water-based drilling fluid to improve the rheological properties of the fluid and/or improve the fluid loss control of the fluid. The polymer is added in the form of an aqueous dispersion of the polymer (Abstract therein). Latexes mentioned by GB 2131067 in the paragraph bridging pages 1 and 2 are polybutadiene, polyisoprene, polyisobutylene, natural rubber latex, ethylene/propylene copolymer and butadiene/styrene copolymer. Again, however, it is respectfully submitted that these latexes are not those now recited in independent claim 20, 24 and 27 as amended herein. (These amendments do not constitute improper insertions of new matter; please see the discussion of the amendments to the claims in the section above with respect to Ricci, et al.) It is thus respectfully submitted that the single GB 2131067 prior art reference does not disclose each and every limitation of the claims, as amended herein. The 35 U.S.C. §102(b) rejection is thus overcome. Reconsideration is respectfully requested.

Double Patenting Rejection


The Examiner rejected claims 20-38 and 43 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 14-31 of U.S. Pat. No. 6703351. Although the Examiner admits that the conflicting claims are not identical, the Examiner contends that they are not patentably distinct from each other because they are not of identical scope, such claims of U.S. Pat. No. 6703351 teach the same components of the present claims used in

the same method, and thus would render the present claims obvious to one of ordinary skill in the art. The Examiner notes that claim 43 differs in teaching the use in sand formations, however, in drilling, encountering either sand or shale formations will occur, and such would be obvious to one of ordinary skill in the art. The Examiner helpfully notes that a timely filed terminal disclaimer in compliance with 37 CFR §1.321(c) or §1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory obviousness-type double patenting ground.

The Examiner's attention is respectfully directed to the enclosed terminal disclaimer in compliance with 37 CFR §1.321 signed by a registered attorney of record which thus overcomes the subject rejection. The Assignee of record for the instant application is Baker Hughes Incorporated, which is identical to the Assignee of U.S. Pat. No. 6703351 on its face, and which has not changed since its original assignment. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments, amendments and terminal disclaimer presented above overcome the rejections and place the claims in condition for allowance. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his continuing duty to indicate allowable subject matter. The Examiner is also invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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